

**REMARKS**

Claims 1, 4, and 44 have been amended, and claims 1, 2, 4, 5, and 42-45 are pending and under consideration. The amendments and remarks contained herein are respectfully requested to be entered as the same present the claims in better form for appeal. No new matter is presented in this Amendment.

**REJECTIONS UNDER 35 U.S.C. §112:**

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner states that "[t]he claim recites "computer readable data storage medium", however, such language is not present in the specification." Office action at page 2. As the Applicants have previously argued, the specification surely provides description sufficient to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the "computer readable data storage medium" as recited in claims 1, 2, 4, and 5. However, without conceding the correctness of the Examiner's assertion, but to expedite examination of the current application, claim 1 has been amended to recite "[a] computer readable data storage medium for use with a recording and/or reproducing apparatus[.]". Such recitation finds direct support in paragraph [0017], which states "[a]ccording to an aspect of the present invention, there is provided a data storage medium[.]". As such, it is respectfully requested that these rejections be withdrawn and that claims 1, 2, 4, and 5 be allowed to issue.

**REJECTIONS UNDER 35 U.S.C. §102:**

Claims 1, 2, 4, 5 and 42-45 are rejected under 35 U.S.C. §102(b) as being anticipated by Taira et al. (U.S. Patent 6,016,381). The Examiner asserts that the search point table (VTS\_PTT\_SRPT 299) stored in the VTSI file and the TT\_SRPT 279 stored in the VMG file of Taira anticipates the invention as recited in claim 1; however, the Examiner's assertions fail for the following reasons.

Claim 1 recites "a second file comprising navigation data, the navigation data including

control commands which are used to select the reproduction information[.]” The navigation data of the second file includes control commands which are not found in the cited art. The Examiner points to the Title Search Pointer Table TT\_SRPT table 279, which is a portion of the Video Manager Information VMGI 275 as shown in FIG. 27 of the cited reference as an anticipating disclosure. “Written in a second table of the video manager 271, i.e., a title search pointer table (TT\_SRPT) 279, are the start addresses of the video titles stored on the optical disk that are selectable according to a title number entered from the key/display section 4 on the apparatus.” Col. 25, line 65 to Col. 26, line 2. The TT\_SRPT table 279 is merely a look-up table that contains information on start addresses but does not contain control commands as recited in claim 1.

Claim 1 further recites that “the first file and the second file are recorded separately on the data storage medium.” As shown in FIG. 27 of the cited reference, the TT\_SRPT table 279 is recorded in the VMGI 275 as part of the Video Manager VMG. Further, FIG. 26 shows the VMG 271 recorded together with the Video Title Sets VTS#n. Thus, the TT\_SRPT table 279 recorded in the VMGI of the VMG together with the VTS would correspond to the first file recited in claim 1 and not the navigation data including control commands recorded in the second file as recited in claim 1. Specifically, the TT\_SRPT table 279 as disclosed by the cited reference is recorded together with the VTS. Thus, the TT\_SRPT table 279 does not correlate to the navigation data including control commands as recited in claim 1.

FIGs. 26 and 27 of the cited reference are similar to the Applicants’ admitted prior art in FIGs. 2, 3, and 9. FIG. 2 of the current application shows the Volume and File Structure of a conventional DVD in which the VMG and the VTS#n are recorded together. FIG. 3 shows that the VMG includes the VMGI, and FIG. 9 shows that the VMGI includes the TT\_SRPT. Thus, the TT\_SRPT of the VMGI of the VMG and the VTS#n were known to be recorded together. In contrast, claim 1 specifically recites that “the first file and the second file are recorded separately on the data storage medium.”

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Because the Examiner has failed to show that the cited art discloses at least “a second file comprising navigation data, the navigation data including control commands which are used to select the reproduction information,” as recited in claim 1, the Examiner’s rejection of claim 1 fails.

Therefore, it is respectfully requested that this rejection be withdrawn and that claim 1 be allowed to issue.

Because **claims 2, 4, and 5** depend upon and incorporate the features of claim 1, claims 2, 4, and 5 are patentable for at least similar reasons as those with respect to claim 1. Thus, it is respectfully requested that these rejections be withdrawn and that claims 2, 4, and 5 be allowed to issue.

**Claim 42** includes features similar to the features of claim 1. Specifically, claim 42 recites "a reader which reads a first file comprising reproduction information for reproducing audio visual stream data, the reproduction information comprising information indicating a reproduction interval of the audio visual stream data, and a second file comprising navigation data, the navigation data including control commands which are used to select the reproduction information from the data storage medium; and a controller which reproduces the audio visual stream data from the data storage medium based on the first file and the second file, wherein the first file and the second file are recorded separately on the data storage medium." As described above with respect to claim 1, Taira et al. cannot anticipate claim 42. As such, it is respectfully requested that this rejection be withdrawn and that claim 42 be allowed to issue.

Because **claims 43-45** depend upon and incorporate the features of claim 42, claims 43-45 are patentable for at least similar reasons as claim 42. Thus, it is respectfully requested that this rejections be withdrawn and that claims 43-45 be allowed to issue.

Claims 1, 2, 4, 5 and 45-45 are rejected under 35 U.S.C. §102(b) as being anticipated by Kato et al. (U.S. Publication 2002/0164152). The Examiner has reasserted that the Kato reference anticipates the invention as recited in claim 1. However, in the Examiner Interview of April 22, 2009, Examiners Tran and Topgyal agreed with the Applicants that such reference does not anticipate at least "a second file comprising navigation data, the navigation data including control commands which are used to select the reproduction information," as recited in claim 1. See Interview Summary mailed May 12, 2009.

Kato still fails to anticipate the invention as recited in claim 1. "One PlayList is a set of playback domains in the Clip." Kato at paragraph [0172]. The Real PlayList disclosed by Kato appears to be a master playlist that co-owns the information in the Clip such that when the Real PlayList is manipulated, the Clip is manipulated, i.e., if a portion of the Real Playlist is deleted,

the playback domains in the Clip are also deleted. The Virtual PlayList does not co-own the Clip data, but is merely a list of virtual playback domains of Clip, i.e., a list of chosen or manipulated playback domains in the Clip, which does not affect the underlying Clip information. Because the Virtual PlayList is merely a list of virtual domains, the Virtual PlayList does not correspond to "a second file comprising navigation data, the navigation data including control commands which are used to select the reproduction information," as recited in claim 1. Therefore, it is respectfully requested that this rejection be withdrawn and that claim 1 be allowed to issue.

Because **claims 2, 4, and 5** depend upon and incorporate the features of claim 1, claims 2, 4, and 5 are patentable for at least similar reasons as those with respect to claim 1. Thus, it is respectfully requested that these rejections be withdrawn and that claims 2, 4, and 5 be allowed to issue.

**Claim 42** includes features similar to the features of claim 1. Specifically, claim 42 recites "a reader which reads a first file comprising reproduction information for reproducing audio visual stream data, the reproduction information comprising information indicating a reproduction interval of the audio visual stream data, and a second file comprising navigation data, the navigation data including control commands which are used to select the reproduction information from the data storage medium; and a controller which reproduces the audio visual stream data from the data storage medium based on the first file and the second file, wherein the first file and the second file are recorded separately on the data storage medium." As described above with respect to claim 1, Kato et al. cannot anticipate claim 42. As such, it is respectfully requested that this rejection be withdrawn and that claim 42 be allowed to issue.

Because **claims 43-45** depend upon and incorporate the features of claim 42, claims 43-45 are patentable for at least similar reasons as claim 42. Thus, it is respectfully requested that these rejections be withdrawn and that claims 43-45 be allowed to issue.

**CONCLUSION:**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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